



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,855	12/07/2005	Paul J. Coleman	21358P	1554
210 7590 02/12/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER				
TUCKER, ZACHARY C				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
02/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,855

**Applicant(s)**

COLEMAN ET AL.

**Examiner**

Zachary C. Tucker

**Art Unit**

1624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 21, 22, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10, 21, 22, 32, and 33 is/are rejected.
- 7) ☒ Claim(s) 1-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S506)
- Paper No(s)/Mail Date 29Mar08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Requirement for Restriction  
~and~  
Election of Species***

A written Requirement for Restriction, and an associated requirement for applicants to elect a single disclosed species, was mailed to applicants on 27 December 2007.

In reply to that Requirement, applicants indicated election of the invention of Group I (claims 1-7 in part), drawn to 2,7a-dihydro-1H-pyrrolo[1,2-c][1,3]oxazol-3-ones, without traverse, based on applicants' incomplete reply. No traversal of the Requirement was voiced, but non-traversal was not specifically voiced either.

In reply to the requirement for applicants to elect a single disclosed specie of the invention of Group I, applicants indicated compound 1-9, found on page 77 (as opposed to page 70, as indicated by applicants in the reply) of the specification. Compound 1-9 is actually disclosed as two compounds, 1-9a and 1-9b, which are stereoisomers of one another. These two compounds are the first two named species in instant claim 7.

With applicants' election of species in mind, a search of the prior art was undertaken. No prior art anticipating or rendering obvious the compound elected as the elected species was found, whereupon the search was broadened and extended, eventually to include all of Group I subject matter. No prior art anticipating or rendering obvious any compound according to Group I was found. Therefore, claims 1-7 (in part), wherein the compounds and composition according to claims 1-7 are not those provided for in Group I are hereby withdrawn from consideration.

Art Unit: 1624

Claims 8-10, 21, 22, 32 and 33, of Group V are hereby now rejoined with claims from Group I, commensurate in scope with Group I claims, and the Requirement for Restriction between Groups I and V is hereby withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-10, 21, 22, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 8-10, 21, 22, 32 and 33 are not enabled due to the level of ordinary skill most nearly connected with the invention, at the time the invention was made, not having progressed to a level commensurate in scope with that which is claimed.

To wit, the following reference, authored by Yildiz and Selvin,

Yildiz and Selvin, "Kinesin: walking, crawling or sliding along?" *TRENDS In Cell Biology*, vol. 15(2), pages 112-120 (February 2005).

Flatly states that clinical applications [of kinesin inhibition] require a deeper understanding of the mechanism and regulation of the motor proteins. Due to the fact that motor proteins were not understood well enough to apply the inhibition thereof to the clinical application of that activity, at the time the invention was made, the methods specified in claims 8-10, 21, 22, 32 and 33 are not enabled by the disclosure. The instant specification

Art Unit: 1624

includes no teaching which would enable the skilled physician to practice the method of claims 8-10, 21, 22, 32 and 33, nor does it teach fully "how to use" the claimed invention in claims 32 and 33.

Furthermore, the limitation "or preventing..." recited in claims 8-10 and 21, is not enabled, simply because prevention of cancer, in general, requires 100% effectiveness of the compounds according to the invention, in stopping the occurrence of cancer, any and all cancers, in a mammal in need of prevention thereof.

***Allowable Subject Matter***

Claims 1-7 are objected to for recitation of nonelected subject matter, specifically, the subject matter identified as Groups II-IV in the Requirement for Restriction letter, But would be allowable if amended so as to limit the scope of said claims to only that subject matter of Group I, elected without traverse.

Cancellation of claims 8-10, 21, 22, 32 and 33, accompanied by amendment of claims 1-7 so as to limit the scope thereof to only Group I subject matter would prompt allowance of the instant application.

***Conclusion***

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Monday to Friday from 9:00am to 5:00pm. If Attempts to reach the examiner are unsuccessful, contact the examiner's supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

/Zachary C. Tucker/  
Primary Examiner, Art Unit 1624